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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/210,539	12/14/1998	AKIRA ISHIBASHI		5289

7590

03/12/2003

Finnegan, Henderson, Farabow, Garrett & Dunner LLP
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EXAMINER

EGWIM, KELECHI CHIDI

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 03/12/2003

23

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/210,539

Applicant(s)

ISHIBASHI ET AL.

Examiner

Dr. Kelechi C. Egwim

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-8 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-8 and 10-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/2/02 has been entered.

Specification

2. The amendment filed 4/46/02 is still objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure, for reasons cited in the previous Office action. 35 U.S.C.

Claim Rejections - 35 USC § 102/103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 2, 5, 6, 8 and 10-12 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Obuchi et al. or Tsai et al., for reasons cited in previous Office actions.

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Obuchi et al. or Tsai et al., each independently as applied to claims 1, 2, 5, 6, 8 and 10-12 above, and further in view of Yamada et al., for reasons cited in previous Office actions.

Response to Arguments

6. Applicant's arguments filed 12/2/02 have been fully considered but they are not persuasive.

7. Regarding the new matter in the specification, applicant has still not provided evidence to prove that Boinelle #1020, as originally disclosed and also used in the prior art, is not a talc-containing polymer as purchased. The technical data provided by applicant refers to "Boinelle", the composition of which is not in question. However, there is no mention of "Boinelle #1020".

Applicant still has not provided substantial evidence to demonstrate that applicant's Boinelle #1020 is not a talc-containing polymer as originally disclosed. While applicant contends that the original disclosure was due to a translational error, the subject matter is of such a substantial nature as to potentially distinguish one of the cited references from the present claims. Substantial evidence is still required.

It is still asserted that Applicant makes it clear in the original specifications that "Bionelle #1020", **the grade of Bionelle** used in the present invention **comprises 30% talc**. In page 36, lines 17-23 and col. 37, lines 3-7 of the present specifications,

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Applicant explicitly **defines** Bionelle 1020 as "commercially available . . . **talc-containing (30%) grade of the aliphatic polyester type biodegradable resin** made by Showa Highpolymer Co., Ltd and **sold under the trademark designation of 'Bionelle' #1020**". As such, the prior art composition. is essentially the same as the claimed composition.

8. Regarding Tsai et al., in response to Applicant's Declaration under 37 C.F.R. § 1.131 and invention reports (dated 9/17/97 and 10/31/97), it does not appear that any single one of the invention reports includes the combination of **each and very limitation** in independent claims 1 or 12, i.e., both the dispersed PLA and the dispersed inorganic filler. Thus, the Declaration is not persuasive.

9. Regarding applicant's arguments that Obuchi et al. does not disclose or suggest a fastening component made from the biodegradable resins, in col. 9, line 32, Obuchi et al. teach that tying materials are among the articles that may be molded from the resin. A tying material is used for fastening.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (703) 306-5701. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone numbers for

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the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

A handwritten signature in black ink, appearing to be 'KCE', with a long horizontal flourish extending to the right.

KCE
March 6, 2003